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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,039	02/20/2002	Jack J. Richards	4244P2431	9546
23504	7590	08/01/2005	EXAMINER	
WEISS & MOY PC 4204 NORTH BROWN AVENUE SCOTTSDALE, AZ 85251			JUSKA, CHERYL ANN	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 08/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/082,039

Applicant(s)

RICHARDS, JACK J.

Examiner

Cheryl Juska

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2005.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-9,19-23,25,29,32 and 33 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1,3-9,19-23,25,29,32 and 33 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 02/02.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment filed May 6, 2005, has been entered. Claims 1, 3-9, 23, and 29 have been amended as requested. Claims 2, 10-18, 24, 26-28, 30, and 31 are cancelled. Thus, the pending claims are 1, 3-9, 19-23, 25, 29, 32, and 33.
2. Said amendment is sufficient to withdraw the 112, 2<sup>nd</sup> rejections set forth in sections 4-7 of the last Office Action. Additionally, the cancellation of claim 30 renders moot the double patenting rejection set forth in section 11 of the last Office Action. Furthermore, said amendment is sufficient to overcome the 103 rejections set forth in sections 13 and 14 of the last Office Action. However, an updated search of the prior art has produced the newly cited Skolnick reference for which to base rejections upon.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. Claims 19-22, 29, 32, and 33 stand rejected under 35 USC 103(a) as being unpatentable over US Re. 34,816 issued to Poettgen as set forth in section 15 of the last Office Action.

***Response to Arguments***

5. Applicant's arguments filed with the amendment have been fully considered but they are not persuasive.

6. Applicant traverses the above Poettgen rejection by arguing that the reference is not directed to the claimed drapery, but rather to a surgical drape (Amendment, paragraph spanning pages 10-11). This argument is unpersuasive since the claimed drape is merely descriptive of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). It is asserted that the structure of the prior art is capable of being employed as a drapery.

With respect to the new limitations of independent claim 29 (Amendment, paragraph spanning pages 11-12), it is argued said limitations do not patentably distinguish the present invention from the prior art since said limitations are not necessarily positive recitations to the structure of the claimed product. Rather, said limitations are "capable of" limitations. It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Thus, the above rejection is maintained.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Applicant claims a drape comprising, in order, a fabric, a first acrylic latex layer, a metallized film, and second acrylic latex layer. Claim 23 is a method of making a drape similar to the drape of claim 1, but with the metal layer on both sides of the film layer. Claims 29 and 33 are drawn to a method of making a drape and said drape, wherein said drape comprises, in order, a fabric, metal layer, film layer, metal layer, and fabric.

9. Claims 1, 6, and 9 are rejected under 35 USC 102(b) as being anticipated by US 4,230,763 issued to Skolnick.

Skolnick discloses a drapery fabric comprising a fabric and a metallized film (abstract). In one embodiment, the drapery fabric comprises, in order, a first fabric layer, a first adhesive layer, a metal layer, a film layer, a second adhesive layer, and a second fabric layer (Figure 3, col. 2, lines 47-51). The metal and film layers may be a polypropylene film vapor deposited with a metal such as aluminum (col. 2, line 55 – col. 3, line 25). The adhesive layers may be an acrylic polymer (col. 3, lines 26-35). Thus, claims 1, 6, and 9 are anticipated by the Skolnick reference.

***Claim Rejections - 35 USC § 102/103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 7 is rejected under 35 USC 102(b) as being anticipated by, or in the alternative, under 35 USC 103(a) as being unpatentable over the cited Skolnick reference.

Although Skolnick does not explicitly teach the claimed optical rating of aluminum, it is reasonable to presume that the limitation is inherent to the invention. Support for said presumption is found in the use of similar materials (i.e., metallized film of aluminum) and in the similar production steps (i.e., deposition of said aluminum metal on a polymeric film) used to produce the metallized film. The burden is upon the applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 495. In the alternative, the claimed optical rating would obviously have been provided by the process disclosed by Skolnick. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102. Therefore, claim 7 is also rejected.

***Claim Rejections - 35 USC § 103***

12. Claims 4, 5, 8, 19-23, 29, 32, and 33 are rejected under 35 USC 103(a) as being unpatentable over the cited Skolnick reference.

While Skolnick does not explicitly teach the use of a flame retardant in the acrylic adhesive layer, it would have been readily obvious to one skilled in the art to employ such an

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additive. Specifically, flame retardant additives are common to fabric drapery due to governmental requirements for resistance to fire. Applicant is hereby given Official Notice of this fact. The examiner notes that the facts asserted to be common and well-known are capable of instant and unquestionable demonstration as being well-known. To adequately traverse such a finding, applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. Therefore, it would have been readily obvious to one skilled in the art to incorporate a flame retardant into the adhesive layer in order to provide the drapery with resistance to fire. Hence, claims 4 and 5 are rejected.

Although Skolnick does not explicitly teach the claimed thickness of the metal layer, it would have been obvious to one skilled in the art to select a thickness within the range claimed. Specifically, Skolnick teaches the thickness is measured and controlled by the reduction in light transmission required (col. 3, lines 9-17). Skolnick then states, "This generally results in a highly reflective metallic layer on the order of, but not limited to, 10-141 Angstroms thick." (Col. 3, lines 17-19). Thus, Skolnick does explicitly teach how to determine an appropriate thickness and that the thickness is not limited to the disclosed range. Therefore, it would have been readily obvious to one skilled in the art to manipulate the thickness of the metal layer in order to optimize the light transmission. It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 205 USPQ 215. Hence, claim 8 is also rejected.

While Skolnick does not explicitly teach the metallized film comprises a metal layer on both sides of the film, it would have been obvious to one skilled in the art to modify the Skolnick

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invention to provide a double-sided metallized film in order to further enhance the thermal and blackout properties of the drapery and/or to produce a reversible drapery. Therefore, claim 23 is also rejected.

Regarding claims 19, 22, 29, and 33, while the claims do not include a positive recitation to acrylic layers, said claims do not exclude the presence of Skolnick's adhesive layers. As such, claims 19, 22, 29, and 33 are also rejected as being obvious over the cited prior art.

Claims 20, 21, and 32 are also rejected based upon the arguments set forth above for the rejections of claims 8 (i.e., thickness limitation) and 7 (i.e., optical rating).

13. Claims 3 and 25 are rejected under 35 USC 103(a) as being unpatentable over the cited Skolnick reference in view of US 4,488,552 issued to McCann et al. and/or US 4,507,342 issued to Kielbania, Jr.

Skolnick fails to teach a fabric layer comprised of a flocked fabric. However, it is known in the drapery art to employ flocked fabrics. For example, McCann teaches lined drapery fabrics may be flocked or unflocked (col. 3, lines 34-48), while Kielbania teaches flock-coated item are useful as decorative draperies (col. 15, lines 38-40). Thus, it would have been readily obvious to one skilled in the art to employ a flocked fabric for the drapery fabric of Skolnick in order to provide a soft, drapable fabric having good insulating properties. Therefore, claims 3 and 25 are also rejected.

### ***Conclusion***

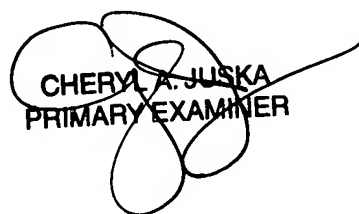
14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.



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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
CHERYL A. JUSKA  
PRIMARY EXAMINER

cj  
July 25, 2005